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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,352	04/26/2001	Moshe Shavit	782.1099	6968

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/842,352

Applicant(s)

SHAVIT ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-19 are pending in this office action.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 13, 16, and 19 recite the limitation "the highest priority" in line 12 on page 3, line 4 on page 5, line 17 on page 5, and lines 5-6 on page 6, respectively. There is insufficient antecedent basis for this limitation in the claim.
4. Claims 2, 15, and 17 recite the limitation "the reachability" in line 17 on page 3, lines 11-12 on page 5, and lines 22-23 on page 5, respectively. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 8 and 9 recite the limitation "the first delivery device" in lines 9 and 13 on page 4, respectively. There is insufficient antecedent basis for this limitation in the claim.
6. Claims 18 recite the limitation "the last delivery device" in line 25 on page 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 19 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent Application Publication No. US 2002/0087704 by Chesnais et al, hereinafter Chesnais.

Regarding claim 19, Chesnais discloses a method of selecting a delivery device for a message (see Abstract), comprising: receiving priority tables of delivery devices, respectively, for each of a plurality of message recipients, the priority tables being customized for each message recipient (page 1, section 0004, lines 1-10; page 2, section 0025, lines 1-2; page 2, section 0031, line 1 – page 3, section 0031, line 16); allowing the priority tables to be dynamically changed for each message recipient (page 3, section 0033, lines 1-16; page 15, section 0251, lines 1-14); selecting, for each message to be transmitted, a delivery device having a highest priority from a corresponding priority table and determining whether the recipient of the message to be transmitted is available on the selected device (page 14, section 0228, lines 1-3; page 14, section 0241, lines 1-15); and continuing, for each message recipient that is not available on the selected device, to sequentially select another delivery device according to the corresponding priority table and to send the message to be transmitted to the selected delivery device, until the message recipient is available on the selected device (page 6, section 0049, lines 1-10).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2002/0087704 by Chesnais et al, hereinafter Chesnais in view of U.S. Patent No. 6,147,977 by Thro et al, hereinafter Thro.

Regarding claim 1, Chesnais discloses a method for selecting a delivery mechanism for a Message (see Abstract), comprising: creating, by a recipient of the message, a priority table of delivery devices of a recipient of the message; selecting a delivery device from the priority table having a highest priority and sending the message to the selected device (page 2, section 0031, line 1 – page 3, section 0031, line 16); and inherently continuing, if the recipient did not receive the message using a highest priority delivery device, to sequentially select another delivery device according to the priority table and send the message to the selected delivery device, until the recipient receives the message (page 6, section 0049, lines 1-10).

Chesnais does not disclose creating, by a sender of the message, a priority table of delivery devices of a recipient of the message.

Thro discloses a method and apparatus that processes messages within a wireless communications system based on originator or sender priority and recipient priority (see Abstract). In Figure 2, the known parties table (Figure 2, 72) shows that a message sent to a recipient has a priority designated by the sender (column 5, lines 26-45). Wherein the sender of

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a message creates a priority table of priority levels for messages sent to a recipient. Depending on the priority level, a delivery device is chosen as shown in Figure 2, 80.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Chesnais to include creating a priority table by the sender as taught by Thro to select a particular delivery device by priority in order to send a message to a recipient. One of ordinary skill in the art would have been lead to make such a modification in order for a sender to efficiently transmit a message to a recipient with confidence that the message reaches the recipient using a delivery mechanism chosen by the sender, without sending a duplicate message to each one of the recipient's mailboxes.

Regarding claim 2, the method of claim 1 mentioned above, wherein Chesnais further discloses determining a reachability of a recipient before sending the message to the selected delivery device (page 3, section 0035, lines 1-28; page 14, section 0228, lines 1-3; page 14, section 0241, lines 1-15).

Regarding claim 3, the method of claim 1 mentioned above, wherein Chesnais further discloses if the message has not been delivered to the recipient after a last delivery device inherently has been selected, selection of delivery devices inherently begins again, starting with the highest priority delivery device in the priority table, after a predetermined time has expired (page 6, section 0048, line 1- page 6, section 0049, line 10; page 10, section 0158, line 1 – page 10, section 0163, line 4; page 12, section 0199, lines 1-25).

Regarding claim 4, the method of claim 1 mentioned above, wherein Chesnais further discloses the priority table is configured in a way that all messages are sent to the recipient using

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a particular delivery device, e.g. an instant messaging (page 13, section 0219, line 1 – page 14, section 0239, line 9).

Regarding claim 5, the method of claim 4 mentioned above, wherein Chesnais further discloses the priority table inherently comprises a name/ID of the recipient, the delivery device, and a delivery address for the delivery device (see Figure 2; page 2, section 0031, line 23 – page 3, section 0031, line 16; page 3, section 0034, lines 12-32; page 4, section 0040, lines 1-9).

Regarding claim 6, the method of claim 1 mentioned above, wherein Chesnais further discloses the priority table is configured in a way that a delivery device is selected according to time of day and day of week (page 3, section 0031, lines 1-16).

Regarding claim 7, the method of claim 6 mentioned above, wherein Chesnais further discloses the priority table inherently comprises a name/ID of the recipient, a list of delivery times and dates, delivery devices corresponding to the delivery times and dates, and delivery addresses corresponding to the delivery devices (page 3, section 0031, lines 1-16; page 3, section 0032, lines 1-12; page 3, section 0034, lines 12-32; page 4, section 0040, lines 1-9).

Regarding claim 8, the method of claim 1 mentioned above, wherein Chesnais further discloses the priority table is configured in a way that a first delivery device selected to send a current message is the same device used to deliver a previous message to the recipient, and the previous message was inherently delivered within a predetermined amount of time before the current message is sent (page 3, section 0032, lines 1-12; page 14, section 0228, line 1 – page 14, section 0234, line 31).

Regarding claim 9, the method of claim 1 mentioned above, wherein Chesnais further discloses the priority table is configured in a way that a first delivery device selected to send a

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current message inherently is a same type of device as the type of device used by the sender to create the message, e.g. if both sender and recipient are using an instant messaging service (page 13, section 0224, lines 1-15).

Regarding claim 10, the method of claim 1 mentioned above, wherein Chesnais further discloses the sender sends a message to one or more recipients (page 1, section 0004, lines 1-10) and there is a priority table for each recipient (page 2, section 0031, line 1 – page 3, section 0031, line 16).

Chesnais does not disclose the sender creates a priority table for each recipient.

Thro discloses a method and apparatus that processes messages within a wireless communications system based on originator or sender priority and recipient priority (see Abstract). In Figure 2, the known parties table (Figure 2, 72) shows that a message sent to a recipient has a priority designated by the sender (column 5, lines 26-45). Wherein the sender of a message creates a priority table of priority levels for messages sent to recipients (see Figure 2, 72; Party ID: 0001, 0002, 0003). Depending on the priority level, a delivery device is chosen as shown in Figure 2, 80.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Chesnais to include creating a priority table by the sender as taught by Thro to select a particular delivery device by priority in order to send messages to recipients. One of ordinary skill in the art would have been lead to make such a modification in order for a sender to efficiently transmit a message to a recipient with confidence that the message reaches the recipient using a delivery mechanism chosen by the sender, without sending a duplicate message to each one of the recipient's mailboxes.



Regarding claim 11, the method of claim 1 mentioned above, wherein Chesnais further discloses the delivery device comprises one of a 3G wireless device, a mobile phone, a fixed telephone, a personal computer, a facsimile device, a pager, and a personal digital assistant (page 2, section 0028, lines 1-7; page 4, section 0039, lines 1-25).

Regarding claim 12, the method of claim 1 mentioned above, wherein Chesnais further discloses a format of the message comprises one of a voice message, a text message, an electronic mail message, an instant message, a short message service message, and a video message (page 4, section 0040, lines 10-27).

Regarding claim 13, Chesnais discloses a system for selecting a delivery mechanism of a message (see Abstract), comprising: a preferences and profile database containing a priority table, created by a recipient of the message, of delivery devices of a recipient of the message (Figure 1, 110; page 2, section 0031, lines 1-13); and a priority delivery selection logic unit inherently selecting a delivery device from the priority table having a highest priority and sending the message to the selected device (page 4, section 0043, line 1 – page 5, section 0043, line 1-18), and continuing, if the recipient did not receive the message using a highest priority delivery device, to sequentially select another delivery device according to the priority table and send the message to the selected delivery device, until the recipient receives the message (page 6, section 0049, lines 1-10).

Chesnais does not disclose creating, by a sender of the message, a priority table of delivery devices of a recipient of the message.

Thro discloses a method and apparatus that processes messages within a wireless communications system based on originator or sender priority and recipient priority (see

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Abstract). In Figure 2, the known parties table (Figure 2, 72) shows that a message sent to a recipient has a priority designated by the sender (column 5, lines 26-45). Wherein the sender of a message creates a priority table of priority levels for messages sent to a recipient. Depending on the priority level, a delivery device is chosen as shown in Figure 2, 80.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Chesnais to include creating a priority table by the sender as taught by Thro to select a particular delivery device by priority in order to send a message to a recipient. One of ordinary skill in the art would have been lead to make such a modification in order for a sender to efficiently transmit a message to a recipient with confidence that the message reaches the recipient using a delivery mechanism chosen by the sender, without sending a duplicate message to each one of the recipient's mailboxes.

Regarding claim 14, the system of claim 13 mentioned above, wherein Chesnais further discloses the priority delivery selection logic unit and the preferences and profiles database are located within a store and forward portion of a multimedia messaging system (see Figure 1: 100, 110; Figure 2, 200).

Regarding claim 15, the system of claim 13 mentioned above, wherein Chesnais further discloses determining a reachability of the recipient before sending the message to the selected delivery device (page 3, section 0035, lines 1-28; page 14, section 0228, lines 1-3; page 14, section 0241, lines 1-15).

Regarding claims 16-18, please see the rejection of the method in claims 1-3 mentioned above, respectively, to reject the computer-readable storage in claims 16-18.

***Response to Argument***

11. The declaration filed on March 17, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Agarwal reference.

12. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Agarwal reference. Exhibit A (the Invention Disclosure Record) does not disclose a priority date before the date of the Agarwal reference.

13. The declaration is insufficient because it is unsigned by all named inventors of the application. See MPEP § 715.04.

14. Applicant's arguments, see pages 7-10, filed March 17, 2004, with respect to the rejection(s) of claim(s) 1-18 under 35 USC 102(e) being clearly anticipated by Agarwal, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent Application Publication No. US 2002/0087704 by Chesnais in further view of U.S. Patent No. 6,147,977 by Thro. Please see the 103(a) rejection(s) above for those claims. Also, a new ground(s) of rejection is made in view of U.S. Patent Application Publication No. US 2002/0087704 by Chesnais. Please see the 102(e) rejection(s) above for claim 19.

15. Applicant's arguments with respect to claim 1-19 have been considered but are moot in view of the new ground(s) of rejection.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE NON-FINAL.**

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***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2002/0067806 by Rodriguez et al teach a system and method for notifying a user of urgent phone messages; multiple locations, such as pagers, email addresses, and alternate phone numbers are contacted in order to inform the user of the urgent message

18. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
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**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

May 29, 2004

Allan Hoosain  
ALLAN HOOSAIN  
PRIMARY EXAMINER  
for  
Fan Tsang